REMARKS

1.   Present Status of Patent Application

This is a full and timely response to the outstanding Office Action mailed March 15, 2004. Claims 51-57 have been added. Reconsideration and allowance of the application and presently pending claims are respectfully requested. Claims 1-7, 10-36, and 38-57 remain pending in the present application.

2.   Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Nguyen spent with Applicant's Attorney during a telephone discussion on April 20, 2004 regarding the outstanding Office Action. Applicant believes that certain important issues were identified during the telephone discussion, and that they are resolved herein. In particular, the rejections of the outstanding Office Action were discussed in regard to the cited *Katz* reference and Applicant's pending claims.   During that conversation, Applicant and the Examiner discussed the proper interpretation of the claims, such as with regard to the term "billing message" and the term "reuse."   Accordingly, Applicant has provided additional arguments directed to this issue. Thus, Applicant respectfully requests that the Examiner carefully consider this response.

3.   Response to Rejection of Claims 10-17, 26-29, 34-36, 39, 44-50 under 35 U.S.C. § 103(a)

In the Office Action, claims 10-17, 26-29, 34-36, 39, and 44-50 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Katz* (U.S. Patent No. 6,424,706) in view of *Benyacar* (U.S. Patent No. 5,003,584). For a proper rejection of a claim under 35 U.S.C. § 103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

a. ***The Office Action Fails to Establish a Proper Motivation to Combine Katz and Benyacar, as Suggested***

The Office Action states, "it would have been obvious to one of ordinary skill in the art . . . to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunications account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system."

Katz and *Benyacar*, however, do not provide the necessary suggestion or motivation for supporting the proposed combination. First, *Katz* discloses an approach directed to "allow[ing] [a] subscriber to purchase . . . unit minutes, transfer[ring] the unit minutes to others (including non-subscribers) and redeem[ing] the unit minutes, and to us[ing] the unit minutes to purchase telephone minutes and redeem[ing] for goods and services. Col. 4, lines 51-56. As such, *Katz* does not utilize billing messages and provides no hint or suggestion for utilizing billing messages (as allegedly disclosed in *Benyacar*) to facilitate its approach toward transferring unit minutes.

As explained in the Manual of Patent Examining Procedure, the words of a claim must be given their plain meaning and read as they would be interpreted by those of ordinary skill in the art. *See* MPEP Section 2111.01; *Toro Co. v. White Consol. Indus. Inc.*, 199 F.3d 1295, 1299, 53 U.S.P.Q.2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."). With respect to Applicant's pending claims, the claims respectively refer to a "billing system" and/or "billing message." Accordingly, within the field of Applicant's disclosure, "[s]tandard billing message formats for circuit-switched telephony have been defined by organizations such as Telcordia (formerly Bellcore). Today, automatic message accounting (AMA) and the Bellcore AMA format (BAF) are examples of industry-standard billing record formats." *See, e.g.,* http://www.cablelabs.com/news/newsletter/ SPECS/March_April_SPECSTECH/tech.pgs/story2.html; Figure 1 of http://www.bcr.com/ bcrmag/2001/08/p28.asp; www.oiforum.com/public/documents/OIF-CDR-01.0.pdf ("Automatic

Message Accounting (AMA) is the process used by circuit-switching systems, packet-switching systems, and other network elements to generate data from which customers are billed for their use of network services.").

Correspondingly and consistent therewith, Applicant's specification describes a billing message for passing information from a caller and/or communication to a billing system, and cites a Structure Code 223, Automatic Message Accounting (AMA) billing record (described in BellCore Automatic Message Accounting Format, G.R. 1100 Issue 3 (Dec 1998)) as one example, among others, of a billing message. Page 30-31, lines 17-5. Accordingly, Applicant's claims describe various embodiments for utilizing information contained within a billing message to perform various transactions as understood in the art.

Katz, however, provides alternative mechanisms for recording unit minute transfers and for notifying users of such transfers that do not involve billing messages and/or billing systems as these terms are ordinarily understood in the field of the disclosure. Moreover, *Katz* seemingly teaches away from the use of billing messages and/or billing systems as allegedly taught by *Benyacar*. For example, *Katz* expressly provides for transaction receipts, among others, to be provided to users via "voice recording, page or facsimile message" and "email messages." Col. 10, lines 26-29.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed.Cir.1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. . . . "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure . . . In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added). *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed.Cir.1988). In the present application, the Office Action has clearly failed to satisfy this evidentiary standard, which the Federal Circuit, in *In re Sang-Su Lee*, held that the Administrative Procedures Act mandates. For this reason alone, the rejections of the Office Action should be withdrawn. The following sets forth separate and independent bases for the patentability of these claims.

b. Claim 10

As provided in independent claim 10, Applicant claims:

> 10. A method for executing a transaction with respect to an account, comprising:
>
> receiving a communication on a calling line associated with a calling line number;
>
> obtaining an account number and a transaction amount from the communication, the account number corresponding to an account with respect to which a transaction is to be conducted, the account associated with a recipient other than a subscriber associated with a calling line number account associated with the calling line number;
>
> creating a billing message for billing telephone service usage with respect to the calling line number;
>
> *reusing a plurality of fields in the billing message to hold elements of transaction information, the transaction information including the account number, the transaction amount, and the calling line number; and*
>
> *using the account number and the transaction amount from the billing message to execute the transaction with respect to the account corresponding to the account number.*

(Emphasis added).

Applicant respectfully submits that independent claim 10 is allowable for at least the reason that *Katz* in view of *Benyacar* does not disclose, teach, or suggest anywhere in the specification or in the figures at the least the features of "reusing a plurality of fields in the billing message to hold elements of transaction information . . . and using the account number and the transaction amount from the billing message to execute the transaction with respect to the account corresponding to the account number," as recited in claim 10.

In particular, both *Katz* and *Benyacar* fail to disclose the feature of "reusing a plurality of fields in the billing message to hold elements of transaction information, the transaction information including the account number [associated with an account of a recipient other than

the subscriber], the transaction amount, and the calling line number." (Emphasis added). <u>For example, *Benyacar* fails to disclose, teach, or suggest obtaining an account number of a recipient other than a subscriber of a calling line number account and also fails to disclose the feature of reusing fields of a billing message, where the term "reuse" is generally referring to the utilization of a field previously designated for one purpose (such as for billing telephone network usage) for another purpose (such as holding transaction information) as understood in Applicant's specification and in the field of Applicant's disclosure.</u> *See Application*, pages 31-32, lines 27-14) ("For example, the field of Aggregate period Elapsed Time may hold the transaction identifier," *etc.*); *see also* ComputerUser High Tech Dictionary at http://www.computeruser.com/ resources/dictionary/definition.html?lookup=4437 (In the software context, "reuse" is defined as "To employ code written for one application in a different application."). Since *Katz* also fails to cure this deficiency, the rejection of claim 10 should be withdrawn, for at least this reason alone.

Additionally, neither *Katz* nor *Benyacar* discloses the step of "<u>using the account number and the transaction amount from the billing message to execute the transaction.</u>" (Emphasis added). For example, as shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using information from a billing message to execute the transaction. Accordingly, *Benyacar* discloses that "the present invention may also be utilized to enable the sponsor <u>to bill the</u> caller for goods purchased over the telephone from the sponsor in addition to services provided by the sponsor" but <u>does not provide for information from a billing message to be used to execute a transaction with respect to an account of a recipient other than a subscriber of a calling line number account.</u> (Emphasis added). In contrast, a billing message, in *Benyacar*, may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. Therefore, *Katz* in view of *Benyacar* does not disclose or even suggest all the features of claim 10, and the rejection should be withdrawn.

b. Claims 11-17 and 39

Because independent claim 10 is allowable over the prior art of record, dependent claims 11-17 and 39 (which depend from independent claim 10) are allowable as a matter of law for at least the reason that dependent claims 11-17 and 39 contain all the steps and features of independent claim 10. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 10, dependent claims 11-17 and 39 recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 39, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 39, is not disclosed or suggested by *Katz* in view of *Benyacar*.

Accordingly, the rejection of claims 11-17 and 39 should be withdrawn.

c. Claim 26

As provided in independent claim 26, Applicant claims:

> 26. In a telecommunications system wherein a billing message is created with respect to a communication, wherein the billing message is further created with respect to a calling line number account corresponding to a calling line number associated with the communication, and wherein the billing message is obtained by a billing system having access to the calling line number account and to other accounts, a method for execution of a transaction in the billing system between the calling line number account and one of the other accounts to which the billing system has access, comprising:
>
> providing that the billing message includes an indication for the execution of the transaction, *wherein the indication is contained in at least one field of the billing message that is reused to contain transaction information;*
>
> causing the billing system to make a recognition of the indication in the billing message; and
>
> *in response to an indication in the billing message, causing the billing system to execute the transaction between the calling line number account associated with a subscriber and the one of the other accounts associated with a recipient other than the subscriber.*

(Emphasis added).

Applicant respectfully submits that independent claim 26 is allowable for at least the reason that *Katz* in view of *Benyacar* does not disclose, teach, or suggest anywhere in the

specification or in the figures at the least the features of "in response to an indication in the billing message, causing the billing system to execute the transaction between the calling line number account associated with a subscriber and the one of the other accounts associated with a recipient other than the subscriber," as recited in claim 26.

In particular, both *Katz* and *Benyacar* fail to disclose the feature "wherein the indication [in a billing message] is contained in at least one field of the billing message that is reused to contain transaction information." (Emphasis added). For example, *Benyacar* fails to disclose, teach, or suggest reusing fields of a billing message to hold transaction information, where the term "reuse" is generally referring to utilizing a field previously designated for one purpose (such as for billing telephone network usage) for another purpose (such as holding transaction information) as understood in Applicant's specification and in the field of Applicant's disclosure. *See Application*, pages 31-32, lines 27-14) ("For example, the field of Aggregate period Elapsed Time may hold the transaction identifier," *etc.*); *see also generally* ComputerUser High Tech Dictionary at http://www.computeruser.com/resources/dictionary/definition.html?lookup=4437 (In a software context, "reuse" is defined as "To employ code written for one application in a different application."). Since *Katz* does not cure this deficiency, the rejection of claim 26 should be withdrawn for at least this reason alone. Further, *Katz* and *Benyacar* both fail to disclose the step of "in response to an indication in the billing message, causing the billing system to execute the transaction between the calling line number account associated with a subscriber and the one of the other accounts associated with a recipient other than the subscriber." (Emphasis added).

For example, as shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using information from a billing message to execute the transaction. Accordingly, *Benyacar* discloses that "the present invention may also be utilized to enable the sponsor to bill the caller for goods purchased over the telephone from the sponsor in addition to services provided by the sponsor" but does not provide for information from a billing message to be used to execute a transaction with respect to an account of a recipient other than a subscriber of a

calling line number account. (Emphasis added). In contrast, a billing message, in *Benyacar*, may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. Therefore, *Katz* in view of *Benyacar* does not disclose or even suggest all the features of claim 26, and the rejection should be withdrawn.

d. Claims 27-29 and 44-47

Because independent claim 26 is allowable over the prior art of record, dependent claims 27-29 and 44-47 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27-29 and 44-47 contain all the steps and features of independent claim 26. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 26, dependent claims 27-29 and 44-47 recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

For example, with regard to claim 44, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record," as recited in claim 44, is not disclosed or suggested by *Katz* in view of *Benyacar*. Further, with regard to claim 45, the feature "wherein the transaction is a voting transaction" is not disclosed or suggested by the proposed combination of *Katz* in view of *Benyacar*. Also, the proposed combination fails to disclose, teach, or suggest "wherein the transaction is a registration transaction," as recited in claim 46, or "wherein the transaction is a voucher transaction," as recited in claim 47.

Accordingly, the rejection of claims 27-29 and 44-47 should be withdrawn.

e. Claim 34

As provided in independent claim 34, Applicant claims:

> 34. In a telecommunications system functionally interconnecting a service switching point, a service control point, and an intelligent network element, and the telecommunications system including a billing system functionally connected at least to the service control point for retrieval of billing messages, the billing system including accounts for conducting transactions, a method for using a communication to conduct a transaction with respect to an account, comprising:

receiving the communication at the service switching point, the communication being associated with a calling line number;

causing the service switching point to obtain instructions regarding the communication from a service control point;

based on the instructions from the service control point, causing the service switching point to obtain an account number and a transaction amount from the communication, the account number corresponding to an account with respect to which the transaction is to be conducted in the billing system, the account associated with a recipient other than a subscriber associated with a calling line number account associated with the calling line number;

in response to obtaining the account number and the transaction amount, causing the service switching point to provide the account number, the transaction amount, and the calling line number associated with the communication to the service control point;

in response to receipt of the account number, the transaction amount, and the calling line number, causing the service control point to make an assignment of the account number, the transaction amount, and the calling line number to *a billing message for billing telephone service usage with respect to the calling line number by reusing a plurality of fields in the billing message to hold elements of transaction information, the transaction information including the account number, the transaction amount, and the calling line number in the billing message* and by posting the billing message for obtaining the billing system; and

causing the billing system to retrieve the billing message from the service control point,

to note the assignment of the account number, the transaction amount, and the calling line number to the billing message, and

based on the assignment, to conduct the transaction in the billing system with respect to the account associated with the account number by crediting or debiting the account by at least the transaction amount.

(Emphasis added).

Applicant respectfully submits that independent claim 34 is allowable for at least the reason that *Katz* in view of *Benyacar* does not disclose, teach, or suggest anywhere in the specification or in the figures at the least the features of "causing the billing system to retrieve the billing message from the service control point, to note the assignment of the account number, the transaction amount, and the calling line number to the billing message, and based on the assignment, to conduct the transaction in the billing system with respect to the account associated with the account number by crediting or debiting the account by at least the transaction amount," as recited in claim 34.

Markedly, *Katz* and *Benyacar* each fail to disclose, teach, or suggest "a billing message for billing telephone service usage with respect to the calling line number by reusing a plurality of fields in the billing message to hold elements of transaction information, the transaction information including the account number, the transaction amount, and the calling line number in the billing message." (Emphasis added). For at least this reason alone, the rejection of claim 34 should be withdrawn. Further, *Katz* in view of *Benyacar* fails to disclose the step of "causing the billing system to retrieve the billing message . . . to note the assignment of the account number . . . to the billing message, and based on the assignment, to conduct the transaction in the billing system." (Emphasis added).

For example, as shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using information from the billing message to execute the transaction. Accordingly, *Benyacar* discloses that "the present invention may also be utilized to enable the sponsor to bill the caller for goods purchased over the telephone from the sponsor in addition to services provided by the sponsor" but does not provide for information from a billing message to be used to execute a transaction with respect to an account of a recipient other than a subscriber of a calling line number account. (Emphasis added). Rather, in *Benyacar*, a billing message may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. Therefore, *Katz* in view of *Benyacar* does not disclose or even suggest all the features of claim 34, and the rejection should be withdrawn. In addition, *Katz* and *Benyacar* each fail to disclose, teach, or suggest "reusing a plurality of fields in the billing message to hold elements of transaction information," as previously discussed. (Emphasis added).

For at least each singular reason above, the rejection of claim 34 should be withdrawn.

f. Claim 48

Because independent claim 34 is allowable over the prior art of record, dependent claim 48 (which depends from independent claim 34) is allowable as a matter of law for at least the

reason that dependent claim 48 contains all the steps and features of independent claim 34. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 34, dependent claim 48 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 48, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 48, is not disclosed or suggested by *Katz* in view of *Benyacar*. Accordingly, the rejection of claim 48 should be withdrawn.

g. Claim 35

As provided in independent claim 35, Applicant claims:

> 35. A method for executing a transaction, comprising:
> receiving the communication associated with a calling line number;
> obtaining a transaction amount from the communication;
> ***coding the transaction amount and the calling line number into a billing message for billing telephone service usage with respect to the calling line number by reusing at least one field of the billing message to hold transaction information;***
> posting the billing message;
> obtaining the billing message, and decoding the transaction amount and the calling line number from the billing message; and
> crediting or debiting an account by the transaction amount, the account associated with a recipient other than a subscriber associated with the calling line number.

(Emphasis added).

Applicant respectfully submits that independent claim 35 is allowable for at least the reason that *Katz* in view of *Benyacar* does not disclose, teach, or suggest anywhere in the specification or in the figures at the least the features shown above. For example, neither *Katz* nor *Benyacar* disclose "coding the transaction amount and the calling line number into a billing message for billing telephone service usage with respect to the calling line number by reusing at least one field of the billing message to hold transaction information," as recited in claim 35.

For example, as shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the

feature of using information from the billing message to execute the transaction. Accordingly, *Benyacar* discloses that "the present invention may also be utilized to enable the sponsor <u>to bill the</u> caller for goods purchased over the telephone from the sponsor in addition to services provided by the sponsor" but does not provide for information from a billing message to be used to execute a transaction with respect to an account of a recipient other than a subscriber of a calling line number account. (Emphasis added). Rather, in *Benyacar*, a billing message may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. Therefore, *Katz* in view of *Benyacar* does not disclose or even suggest all the features of claim 35, and the rejection should be withdrawn. In addition, *Katz* and *Benyacar* each fail to disclose, teach, or suggest "<u>reusing</u> at least one field of the billing message to hold transaction information," as previously discussed. (Emphasis added).

For at least each singular reason above, the rejection of claim 35 should be withdrawn.

h. Claim 49

Because independent claim 35 is allowable over the prior art of record, dependent claim 49 (which depends from independent claim 35) is allowable as a matter of law for at least the reason that dependent claim 49 contains all the steps and features of independent claim 35. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claim 49 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 49, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 49, is not disclosed or suggested by *Katz* in view of *Benyacar*. Accordingly, the rejection of claim 49 should be withdrawn.

i. Claim 36

As provided in independent claim 36, Applicant claims:

> 36. A system for allowing a user to initiate a transaction and have the transaction conducted, comprising:
> a service switching point (SSP)
> for receiving a communication from the user, and

for obtaining and acting on instructions regarding the
communication;

a service control point (SCP)

for providing the instructions regarding the communication
to the SSP, the instructions instructing the SSP to retrieve transaction
information and to forward the transaction information to the SCP,

for including the transaction information in a billing message
for billing telephone network service usage to the user by assigning the
transaction information to at least a field of the billing message by *reusing the at
least a field of the billing message,* and

for posting the billing message for retrieval by a billing
system; and

the billing system

for retrieving the billing message,

for recognizing the transaction information in the billing
message, and

*based on the recognition, for conducting the transaction
based on the transaction information,* wherein the SCP is operative to code the
transaction amount into a field of the billing message and the account number into
another field of the billing message, and wherein the billing system is operative to
decode the transaction amount from the field of the billing message and account
number from the another field, and to credit or debit an account by the transaction
amount, the account associated with a recipient other than the user.

(Emphasis added).

Applicant respectfully submits that independent claim 36 is allowable for at least the
reason that *Katz* in view of *Benyacar* does not disclose, teach, or suggest anywhere in the
specification or in the figures at the least the features of "for conducting the transaction based on
the transaction information," and "reusing the at least a field of the billing message," as recited in
claim 36. For example, *Katz* discloses that a unit-minute transaction is executed before
transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the
transaction was successful, a process 485 stores the transaction for later settlement process."
Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using
information from the billing message to conduct the transaction.

Accordingly, *Benyacar* discloses that "the present invention may also be utilized to
enable the sponsor to bill the caller for goods purchased over the telephone from the sponsor in
addition to services provided by the sponsor" but does not provide for information from a billing

message to be used to conduct a transaction with respect to an account of a recipient other than a subscriber of a calling line number account. (Emphasis added). Diversely, in *Benyacar*, a billing message may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. In addition, *Katz* and *Benyacar* each fail to disclose, teach, or suggest "reusing the at least a field of the billing message," as previously discussed. (Emphasis added). Therefore, *Katz* in view of *Benyacar* does not disclose or even suggest all the features of claim 36, and the rejection should be withdrawn.

j. Claim 50

Because independent claim 36 is allowable over the prior art of record, dependent claim 50 (which depend from independent claim 36) is allowable as a matter of law for at least the reason that dependent claim 50 contains all the elements and features of independent claim 36. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 36, dependent claim 50 recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 50, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 50, is not

disclosed or suggested by *Katz* in view of *Benyacar*. Accordingly, the rejection of claim 50 should be withdrawn.

4.   Rejection of Claims 1-7, 18-25, 30-33, 38, and 40-43 under 35 U.S.C. § 103

Claims 1-7, 18-25, 30-33, and 40-43 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Katz* in view of *Benyacar* and *Lesley* (U.S. Patent No. 6,333,976). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical,* 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller,* 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Further, for a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of

the combination must be found in the prior art. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

a. *The Office Action Fails to Establish a Proper Motivation to Combine Katz Benyacar, and Lesley as Suggested*

The Office Action states, "it would have been obvious to one of ordinary skill in the art . . . to utilize the teachings of Lesley into the teachings of Katz in view of Benyacar, so that subscribers can easily add or transfer money from one telecommunications account to other telecommunication account by accessing prepaid network." *Katz, Benyacar* and *Lesley*, however, do not provide the necessary suggestion or motivation for supporting the proposed combination for at least the reasons that have already been discussed above with regard to the proposed combination of *Katz* and *Benyacar*.

b. Claim 1

As provided in independent claim 1, Applicant claims:

> 1. In a telecommunications system functionally interconnecting a service switching point, a service control point, and an intelligent network element, and the telecommunications system including a billing system functionally connected at least to the service control point for retrieval of billing messages, the billing system including telecommunications accounts for charging fees to subscribers with respect to telecommunications services provided to the subscribers, a method for using a communication to conduct a transaction with respect to a telecommunications account, comprising:
> receiving the communication at the service switching point, the communication being associated with a calling line number associated with a first telecommunications account;
> causing the service switching point to route the communication to the intelligent network element;
> causing the intelligent network element to obtain a telecommunications account number and a transaction amount from the communication, the telecommunications account number corresponding to a second telecommunications account with respect to which the transaction is conducted in the billing system;
> in response to obtaining the telecommunications account number and the transaction amount, causing the intelligent network element to provide the telecommunications account number, the transaction amount, and a calling line

number associated with the second telecommunications account and the communication to the service control point;

in response to receipt of the telecommunications account number, the transaction amount, and the calling line number associated with the second telecommunications account, causing the service control point to make an assignment of the telecommunications account number, the transaction amount, and the calling line number associated with the second telecommunications account to *a billing message for billing telephone service usage with respect to the calling line number by reusing a plurality of fields in the billing message to hold at least the telecommunications account number, the transaction amount, and the calling line number;* and

causing the billing system to retrieve the billing message from the service control point,

to note the assignment of the telecommunications account number, the transaction amount, and the calling line number associated with the second telecommunications account, and

based on the assignment, to conduct the transaction in the billing system with respect to the second telecommunications account associated with the telecommunications account number by crediting or debiting the telecommunications account by at least the transaction amount.

(Emphasis added).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Katz* in view of *Benyacar* and *Lesley* does not disclose, teach, or suggest anywhere in the specification or in the figures at the least the features of "a billing message for billing telephone service usage . . . by reusing a plurality of fields in the billing message," "causing the billing system to retrieve the billing message from the service control point . . . [and] to conduct the transaction in the billing system with respect to the second telecommunications account associated with the telecommunications account number by crediting or debiting the telecommunications account by at least the transaction amount," as recited in claim 1.

For example, *Benyacar* and the other references do not disclose, teach, or suggest a billing message to contain a telecommunications account number of a second telecommunications account. Further, *Katz, Benyacar*, and *Lesley* singularly and collectively fail to teach, disclose, or suggest the feature of "causing the billing system to retrieve the billing message from the service control point . . . [and] to conduct the transaction in the billing system." (Emphasis added). For example, as shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B.

Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using information from the billing message to execute the transaction. Further, the deficiencies of *Katz* are not cured by the *Benyacar* and *Lesley* references. For example, with regard to *Lesley*, FIG. 4(a) shows that step 98 to "create billing record and send to billing computer") is performed after step 94 to "provide service up to pre-paid amount." Hence, *Lesley* also fails to disclose, teach, or suggest the feature of "causing the billing system . . . to conduct the transaction," as claimed. Likewise, in *Benyacar*, a billing message may at most be generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. In addition, *Katz, Benyacar,* and *Lesley* singularly and collectively fail to disclose, teach, or suggest "<u>reusing</u> a plurality of fields in the billing message," as previously discussed. (Emphasis added).

Therefore, the rejections to pending independent claim 1 should be withdrawn, for at least each singular and independent reasons stated above.

b. Claims 2-7 and 38

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-7 and 38 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-7 and 38 contain all the steps and features of independent claim 1. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-7 and 38 recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 3, the feature "wherein the billing system conducts the transaction in billing system by crediting or debiting the calling line number account by at least the transaction amount," as recited in claim 3, is not disclosed or suggested by *Katz* in view of *Benyacar* and *Lesley*. Further, with regard to claim 38, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 38, is not disclosed or suggested by *Katz* in view of *Benyacar* and *Lesley*.

Accordingly, the rejection of claims 4-7 and 38 should be withdrawn.

c. Claim 18

As provided in independent claim 18, Applicant claims:

18. In a system for billing fees to subscribers for provision of telecommunication services, each subscriber having a telecommunications account in the system, the telecommunications account being associated with at least one calling line number, a method to conduct a transaction with respect to a telecommunications account in the system, comprising:

obtaining a billing message generated as a result of a telecommunications service performed with respect to a calling line number, wherein at least one field of the billing message for billing telephone service usage with respect to the calling line number are reused to hold transaction information;

in response to obtaining of the billing message, making a determination that the billing message includes an indication that a transaction is conducted with respect to a telecommunications account in the system, the telecommunications account associated with a recipient other than the subscriber associated with a calling line number account associated with the calling line number; and

in response to the determination, conducting the transaction with respect to the telecommunications account.

(Emphasis added).

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that *Katz* in view of *Benyacar* and *Lesley* does not disclose, teach, or suggest anywhere in the specification or in the figures all of the claimed features above. For example, *Katz* in view of *Benyacar* and *Lesley* fails to disclose, teach, or suggest "in response to the determination [that the billing message includes an indication that a transaction is conducted], conducting the transaction with respect to the telecommunications account." (Emphasis added). As shown in FIG. 4B, *Katz* discloses that a unit-minute transaction is executed before transaction information is stored. *See* steps 481 & 485 of FIG. 4B. Further, *Katz* states: "If the transaction was successful, a process 485 stores the transaction for later settlement process." Col. 19, line 9-12. Therefore, *Katz* fails to disclose, suggest, or teach the feature of using information from the billing message to execute the transaction. Further, the deficiencies of *Katz* are not cured by the *Benyacar* and *Lesley* reference. For example, with regard to *Lesley,* FIG. 4(a) shows that the step 98 to "create billing record and send to billing computer") is performed after step 94 to "provide service up to pre-paid amount." Hence, *Lesley* also fails to disclose, teach, or suggest the feature of "in response to the determination [that the billing message includes an indication that a

transaction is conducted], conducting the transaction," as claimed. Correspondingly, a billing message, in *Benyacar*, is generated after all processing and related transactions have been completed. *See, e.g.,* last step 251 of FIG. 2. Therefore, Applicant respectfully requests that the rejections to pending independent claim 18 be withdrawn. In addition, neither *Katz, Benyacar,* and *Lesley* disclose the claimed feature "wherein <u>at least one field of the billing message</u> for billing telephone service usage with respect to the calling line number <u>are reused</u> to hold transaction information," as claimed and as previously discussed. (Emphasis added). As a result, claim 18 should be allowed for at least each of these singular and independent reasons.

d. Claims 19-25 and 40-43

Because independent claim 18 is allowable over the prior art of record, dependent claims 19-25 and 40-43 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19-25 and 40-43 contain all the steps and features of independent claim 18. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 18, dependent claims 19-25 and 40-43 recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. For example, with regard to claim 40, the feature "wherein the billing message is a Structure Code 223, Automatic Messaging Accounting (AMA) billing record.," as recited in claim 40, is not disclosed or suggested by *Katz* in view of *Benyacar* and *Lesley*. Further, with regard to claim 41, the feature "wherein the transaction is a voting transaction" is not disclosed or suggested by the proposed combination. Also, *Katz* in view of *Benyacar* and *Lesley* fails to disclose, teach, or suggest "wherein the transaction is a registration transaction," as recited in claim 42, or "wherein the transaction is a voucher transaction," as recited in claim 43.

Accordingly, the rejection of claims 19-25 and 40-43 should be withdrawn.

e. Claims 30-33

Because independent claim 26 is allowable over the prior art of record, dependent claims 30-33 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 30-33 contain all the steps and features of independent claim 26.
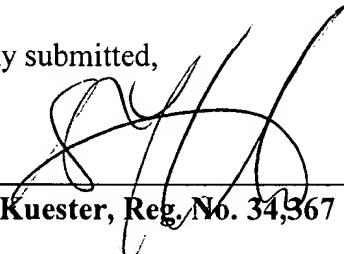
5. <u>Newly Added Claims 51-57</u>

For clarification purposes, claims 51-57 have been added to further clarify some of the features of the respective independent claims. For at least the reasons stated above, claims 51-57 are allowable over the cited art.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that pending claims 1-7, 10-36, and 38-57 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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